

SUMMARY

This is a Response to the Office Action mailed February 6, 2006 and follows on an Examiner Interview on April 11, 2006.

In the Office Action, the Examiner rejected all pending claims under the doctrine of double patenting and as being obvious over the teachings of primary reference Banks in combination with Baumgartner, Marshak, Kameraman and/or Vin.

In the interview there was disagreement with the Examiner over whether the prior art taught a claimed feature as well as over whether it was obvious to combine the references as alleged by the Examiner. Nonetheless, and as summarized in the Examiner's interview summary, the Examiner indicated that "distributed service records at multiple locations" did not seem to be taught by the references of record.

Accordingly, and as suggested by the Examiner, Applicants have made amendments to the independent claims to incorporate this concept. As will be apparent from this Response, Applicants are making these amendments in an effort to obtain expeditious allowance of this application and not because they accept the Examiner's rejections in the Office Action.

In this Response, therefore, all independent claims are amended, certain dependent claims are also amended and 8 claims are added to replace the 8 claims cancelled in the Response to the first Office Action.

A brief discussion follows.

EXAMINER'S INTERVIEW

As a preliminary matter, Applicants and their representative wish to thank the Examiner for the courtesy extended during the April 11 2006 Interview of this application and its three related applications 10/722,051; 10/721,343; and 10/721,905.

At the interview, Applicants asserted that the meaning of the claim language of the words "a service record including ... associated location where the first and second users are logged in" means that the "location information" in the service record(s) relates to the actual location of the relevant user.

The Examiner disagreed arguing that the word 'location' "is a logical designation that reads on the [user's] connection, port, or address" and even covers situations such as that

taught in primary reference Banks where the only user addressing information known to the system is that of ports (very remote from the user) at which the user dials in to one of a bank of mainframe computers in a single room.

Nonetheless, the Examiner did suggest that the concept of "distributed service records at multiple locations" as taught in the specification does not seem to be taught by the references of record.

The amendments in this Response are as a result of that observation and not because the Applicants agree with the Examiner's characterization of the prior art or the obviousness of its combination.

EXAMINER'S REJECTIONS

I. CLAIM REJECTIONS BASED ON DOUBLE PATENTING

In the Office Action, the Examiner rejected the claims based on a judicially created doctrine of double patenting as being un-patentable over the claims of co-pending, related applications 10/722,051; 10/721,343; and 10/721,905.

Applicants have now amended the claims per the Examiner's observations described above. Accordingly, the claims in this application now contain a distinct limitation -- that to multiple service records containing the same user's identification and location information -- not found in any independent or dependent claim in any of these co-pending applications.

Accordingly, Applicants submit that the claims are patentably distinct and that the double patenting rejection should be withdrawn.

II. CLAIM REJECTIONS - 35 USC § 103(a)

The Examiner also rejected the claims under 35 U.S.C. 103

"as being unpatentable over Michael Banks "America Online: A Graphics Based Success Evaluation", and further in view of Baumgartner et al. US patent 5,195,086, and Marshak "Beyond Mail for Windows" and Kameraman et al. US patent 5,519,834, Vin et al. "Multimedia Conferencing in the Etherphone Environment".

In making this rejection, the Examiner alleges that

"Banks teaches a communication system ... comprising:...

c) at least one service record for the first and second logged in users [apparent in order to indicate if a member is currently online. See page 3 first paragraph]; the service record including user identification (screen names) and associated location where the user is logged in no matter where they are located (page 3, 1st paragraph see "where a member is from")

The Examiner then correctly observes that Banks does not disclose certain claimed elements, but that Baumgartner does and that it would be obvious to combine banks with Baumgartner. As this Banks and Baumgartner combination does not teach all the claim elements, the Examiner supplements this combination with teachings from Marshak to support the § 103 rejection. The Examiner also relies on teachings from Kameraman to support § 103 rejections.

III. APPLICANTS' RESPONSE TO THE § 103 REJECTIONS

For the record and as pointed out by the Applicants at the Interview, Applicants believe these rejections cannot be sustained for a number of reasons:

- (a) Banks' dial-up modem system does not, in fact, teach a service record that includes a user location as claimed;
- (b) It is not obvious to combine Banks with Baumgartner; and
- (c) It is also not obvious to combine other references such as Kameraman with Banks as alleged by the Examiner.

Each of these points is developed below.

A. BANKS DOES NOT TEACH A SERVICE RECORD THAT INCLUDES A USER LOCATION

In the Office Action, the Examiner argues that Banks teaches:

...c) at least one service record...and associated location where the user is logged in no matter where they are located (page 3, 1st paragraph see "where a member is from")....

But, as pointed out in the Interview, Banks does not teach this at all. In fact, the Banks' "where a member is from" language has nothing to do with a user's device location, but instead refers to a user's demographic information. It is the town, city, state or country or other geographic place from which the user indicates (truthfully or otherwise) from which he or she hails.

This is apparent from a reading of the entire section from which the language “where a member is from” was extracted. Other contemporary documents confirm this exactly. For example, the section of an “America Online Tour Guide” attached to the Rule 132 affidavit submitted herewith. This quoted section, from pages 70 to 72, clearly shows that the reference to where a member is “from” refers to a geographic location. For example, Figure 3-16 on page 72 shows that member MajorTom is “from” Gresham, Oregon.

Moreover it is unnecessary and, in fact, totally contrary to the operation of the Banks system to maintain a record of user’s log-in location. The reason is simple.

Banks’ system requires the user to access the AOL service by dial-up modem. This modem establishes a connection with one of nine AOL mainframe computers *in a single location*. After dial-in connections are made at the mainframe. This configuration is confirmed by pages 5 to 6 of the “America Online Tour Guide” manual attached to the Rule 132 affidavit submitted herewith.

This system simply does not, therefore, track member log-in locations.

The Examiner did not, however, accept this point of view during the Interview, arguing instead that the claim words ‘associated location where the first and second users are logged in’ refers not to the physical location of the user but rather to “a logical designation that reads on the [user’s] connection, port, or address” and even covers situations such as that taught in Banks where the only user addressing information known to the system is that of the ports (very remote from the user) at which the user dials in to one of a bank of mainframe computers in a single room.

B. IT NOT OBVIOUS TO COMBINE BANKS WITH BAUMGARTNER

Applicants also submit that it is also not obvious to combine Banks with Baumgartner. As explained in the Interview, the references are totally incompatible. Nothing would lead one skilled in the art of Banks’ technology to combine it with a graphical user interface from Baumgartner. Also, history teaches exactly this. The allegedly obvious combination by ICQ (people skilled in the Banks art area) was released for the first time more than two years after this application’s filing date.

Rather than set out the reasons for this in detail here, however, Applicants submit that the amendments made to the claims and as described below, make the claims allowable and thus this rejection moot.

IV. APPLICANTS' AMENDMENTS

Despite disagreement as to what the claim language meant and whether the references were obvious to combine, the Examiner did suggest that the concept of "distributed service records at multiple locations" as taught in the specification does not seem to be taught by the references of record.

Accordingly, Applicants have amended all independent claims – claims 1, 12, 25 and 35 – to reflect this concept. Each of the independent claim therefore has a plurality of service records for each user, each including at least user ID and location information. Each independent claim also includes a limitation to a plurality of service servers, each of which stores at least one service record for the first and second user.

As observed by the Examiner, this concept does not appear in the prior art of record.

In addition, certain new dependent claims have been added. Support for claim 51 is found at at least paragraph [0134]. Support for claims 52 to 58 is found amongst other places at paragraph [0135], and paragraph [0271] in the published application. Certain amendments have also been made to the dependent claims to better claim the subject matter and not in response to any prior art or the Examiner Interview.

CONCLUSION

In summary, all the claims contain at least a limitation to multiple service records containing each of the first and second user's location information. These are stored on multiple servers. This is not taught by, inherent in nor obvious from Banks, alone or in combination with the cited or other known prior art.

Applicants accordingly respectfully submit that all of the pending claims define subject matter that is patentable over the prior art. Their immediate allowance is respectfully requested as soon as possible.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the

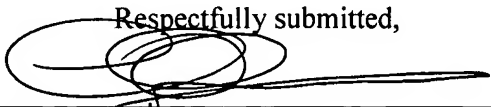
Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 50-0310 (order no. 063330-5010).

Please also credit any overpayments to said Deposit Account.

Date: April 14, 2006

Respectfully submitted,


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